

REMARKS

Claims 1, 2, 4-19, 21-23, 25-28, 30-57, and 59-66 are pending herein, with Claims 1, 46, 53, 54, 58, 59, and 60 being independent claims. All claims stand rejected.

Support for the amendment of "consumer lifestyle data" is found at page 11, lines 30-34:

This consumer lifestyle information is similar to the extensive demographic and socioeconomic consumer information gathered and analyzed in step 300. This information is generally gathered via quantitative attitude and usage studies as well as by quantitative segmentation studies.

The demographic and socioeconomic consumer information is defined at page 10, line 25 - page 11, line 2:

For example, information may be obtained via consumer intercept surveys in the different types of purchasing environments. Other methods include an analysis of transaction data, i.e., the analysis of sales information from checkout counter bar code readers on consumer purchases or from audit data. This information may include what is purchased, cost, frequency, time, amount, combinations of items, marketing or promotional activities or materials, etc. Further methods of determining the relevant types of consumers and their practices include one-on-one in-depth interviews with consumers, qualitative focus groups and quantitative consumer segmentation studies, i.e., segmenting consumers by their "nature of work."

Support for the amendment of "consumer market data" is found at page 12, lines 22-31:

This information is also based largely on extensive demographic and socioeconomic consumer information similar to that gathered and analyzed in step 300 and elsewhere above. Further, this information may include item specific market research, i.e., information obtained by the manufacturer and/or distributor of the item 10 on how that item 10 is used and the needs addressed by the item 10. Other sources of this type of information include one-on-one in-depth interviews to uncover the emotional needs of the consumer, qualitative group research

The Applicant also notes that the use of the "or" terminology is specifically permitted in MPEP §2173.05(h)II.

35 U.S.C. § 101:

Claims 1-45, 46-52, 53, and 54-57 were rejected under 35 U.S.C. §101 as being directed towards nonstatutory subject matter. Specifically, the Examiner stated that the steps or processes as claimed herein should be implemented via a device such as a computer system or a database. The Applicant respectfully traverses the rejection.

The focus of a §101 inquiry is whether the process has "practical utility," *i.e.*, whether the claimed process produces a "useful, concrete, and tangible result." *See State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596, 1602 (Fed. Cir. 1998). The Applicant submits that the amendments made herein easily provide such a "useful, concrete, and tangible" result, *i.e.*, creating a demand for an item through the selection of messaging, brands, packaging, or merchandising.

Further, the Federal Circuit has made it clear that a method or process claim need *not* recite any specific structure for carrying out the process. *AT&T Corp. v. Excel Communications, Inc.*, 50 USPQ2d 1447, 1453 (Fed. Cir. 1999). Similarly, the unpublished Board decision cited by the Examiner, *Ex Parte Bowman*, 61 USPQ2d 1669 (Bd. Pat. App. & Int. 2001) does not (and could not) command a different conclusion. In *Bowman*, the Board affirmed the rejection of a method claim under 35 U.S.C. §101. In that case, there was no mention of any technology in either the claims *or* the specification. "The examiner responds that the noted [Computer Related Inventions] Guidelines are inapplicable here because appellant has not recited the use of a computer in either the specification or the claims." 61 USPQ2d at 1671. One member of the Board specifically noted that the use of a computer or other type of operating environment may be inferred based upon *In re Dossel*, 42 USPQ2d 1881, 1885 (Fed. Cir. 1997)

AO 1012138.1

rather than being specifically recited. Likewise, the use of any type of specific structure is no longer required under the *AT&T* decision:

While *AT&T* clarifies that structure need not be present in the claim language for process claims to be directed to statutory subject matter, the Court appears to impliedly weight that the process is carried out by a network of computers and telephone switches being used in the flow of communications, but here we do not have a similar factual situation.

Id. at 1674 (Dixon, J., concurring).

Here, as recited above, the specification describes in great detail the various ways by which the consumer lifestyle and market data may be gathered and analyzed with and without computers. Although a computer or a database certainly can play a large role in such steps, the prior art does not require that the claims be so limited. The Applicant thus submits that the claims meet statutory requirements of 35 U.S.C. §101.

37 C.F.R. §1.75(c):

Claims 44 and 45 were rejected under 37 C.F.R. §1.75(c) as being in improper dependent form for failing to further limit the subject matter of Claims 1 and 39 respectively. Claims 44 and 45 recite "a computer readable medium having computer executable instructions for performing the steps recited in" Claims 1 and 39. MPEP §2173.05(f) specifically states that such claims are allowable, i.e., "[t]he product produced by the method of claim 1." Given the clear statement of the MPEP and given the dozens of examples of issued claims in exactly this format with exactly this language, the Applicant is prepared to take this issue to the Board.

35 U.S.C. § 112:

Claims 1-45, 46-52, 53, 54-57 were rejected under 35 U.S.C. §112 as being based upon a disclosure that is not enabling. The Applicant submits that the amendments made herein render this rejection moot.

The same claims were rejected under 35 U.S.C. §112 as being indefinite for the same reasons. The Applicant again submits that the amendments made herein render this rejection moot.

35 U.S.C. §102:

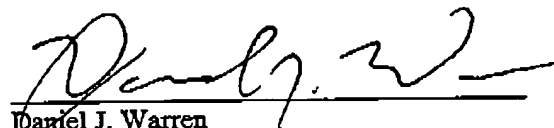
All claims were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,649,114 to Deaton, et al. As discussed with the Examiner, Deaton does not show the use of anything that might be considered consumer lifestyle data. At best, Deaton is concerned with extensive use of various types of register data so as to provide coupons and similar discounts. Further, Deaton is clearly silent on the step of creating demand through the selection of messaging, brands, packaging, and merchandising. Again, Deaton is involved in the provision of coupons. The present invention, however, is based upon the creation of demand through triggers other than price. See Page 2, lines 9-17.

The Applicant traverses the rejection of each dependent claim for the reasons given above and because Deaton is completely silent on such limitations. The Applicant further submits that such limitations cannot be considered inherent in Deaton. See MPEP §2112.

CONCLUSION

The Applicant believes that it has responded to each matter raised in the Office Action. Allowance of all claims is respectfully solicited. Any questions may be direct to the undersigned at 404.853.8028.

Respectfully submitted,


Daniel J. Warren
Reg. No. 34,272

SUTHERLAND ASBILL & BRENNAN LLP
999 Peachtree Street, N.E.
Atlanta, Georgia 30309-3996
(404) 853-8000
daniel.warren@sablaw.com

SAB Docket No.: 25040-0153